

REMARKS

The outstanding Official Action required restriction of the claims in the present application to one of a number of identified distinct (as claimed) inventions (as identified by the Examiner) in accordance with the provisions of 35 U.S.C. § 121. In particular, the Official Action asserted that identified Groups of claims in the present application are directed to the following distinct (as claimed) inventions:

Invention I, to which the claims of Group I comprising claims 1-17 and 21 (as identified by the Examiner) are directed, drawn to a refractometer having a sensor and detector attached to the entrance and exit face. The Official Action asserted that these claims are classified in class 356, subclass 128.

Invention II, to which the claims of Group II comprising claims 18-20 (as identified by the Examiner) are directed, drawn to a refractometer having a comparing means, displaying means, and a light source control means. The Official Action asserted that these claims are classified in class 356, subclass 128.

The Official Action asserted that Inventions I and II are related as combination and subcombination. The Official Action further asserted that the identified combination of Invention I does not require the particulars of the identified subcombination of Invention II, because the claims of Group I directed to Invention I do not require for patentability a comparing means, displaying means, and a light source control means as in the claims of Group II directed to Invention II. The Official Action additionally asserted that the identified subcombination of Invention II has separate utility from the identified combination of Invention I, such as calculating the refractive index of a sample

and detecting an error of an input light source. Thus, the Official Action concluded that restriction for examination purposes is proper.

The Examiner's attention is respectfully directed to MPEP 803 which explicitly sets forth that "if the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits even though they include claims to independent or distinct inventions". In this regard, each of the identified Groups of claims is classified in Class 356, subclass 128. Accordingly, the search for each of these identified Groups of claims would appear to fully overlap and thus would not impose any burden on the Examiner.

Accordingly, for each of the above reasons, it is respectfully submitted that the Restriction Requirement is inappropriate. For these reasons, and consistent with office policy as set forth in MPEP 803, Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement. Nevertheless, in order to be fully responsive, Applicants have elected with traverse the embodiments of the invention identified as Invention I, to which the claims of Group I (i.e., claims 1-17 and 21) are directed (as identified by the Examiner), for prosecution on the merits in the event that the Examiner chooses not to reconsider and withdraw the Restriction Requirement.

The outstanding Official Action also contingently required election between claims in the present application directed to one of several enumerated patentably distinct Species (as identified by the Examiner). In particular, the Official Action asserted that the claims in the present application are directed to the following patentably distinct Species (as identified by the Examiner):

Species I as illustrated in Fig. 8 (as identified by the Examiner), upon which claims 1-4, 21 are readable (as identified by the Examiner), drawn to a refractometer having a light source and a photo-detector attached to the entrance and exit face of the prism.

Species II as illustrated in Fig. 3 (as identified by the Examiner), upon which claims 5-11 are readable (as identified by the Examiner), drawn to a refractometer having a non-adhesive coating sample stage.

Species III as illustrated in Fig. 10 (as identified by the Examiner) and described in the specification at page 22, lines 27-29 (as identified by the Examiner), upon which claims 12-17 are readable (as identified by the Examiner), drawn to a refractometer having a filter means.

As noted above, by the present Response, Applicants have elected Species I (as identified by the Examiner), as illustrated in FIG. 8 (as identified by the Examiner), upon which claims 1-4 and 21 are readable (as identified by the Examiner). Such election is also made with traverse for the following reasons.

In this regard, the identified characteristics of the various identified Species are not independent as defined in MPEP 806.06. In particular, the identified characteristics of the various identified Species do not lack a disclosed relationship or a connection in design, operation and effect. Additionally, the characteristics of the various identified Species are disclosed as capable of use together, and are not alternatives to each other with alternative functions and effect. In any case, the Official Action does not assert that the various above-identified Species are independent. Rather, it appears that the

Election of Species requirement is based upon a belief that the various identified Species are "patentably distinct" Species.

However, as explained below, the characteristics of the various identified Species I, Species II and Species III (as identified by the Examiner) are characteristics attributable to a single exemplary embodiment illustrated at least in FIG. 3, such that the very characterization of these features as belonging solely to the different identified Species is incorrect. Accordingly, claims 1-17 and 21 are not properly subject to an Election of Species requirement. As explained below, the embodiment of at least FIG. 3 illustrates the identified characteristics of Species I ("a refractometer having a light source and a photo-detector attached to the entrance and exit face of the prism"), the identified characteristics of Species II ("a refractometer having a non-adhesive coating sample stage"), and the identified characteristics of Species III ("a refractometer having a filter means").

In this regard, the identified characteristics of Species I ("a refractometer having a light source and a photo-detector attached to the entrance and exit face of the prism"), are asserted to be illustrated solely in the embodiment of at least FIG. 8. However, the above-noted features of Species I (as identified by the Examiner) are illustrated in the single embodiment of at least FIG. 3 and described at, e.g., pages 5-8 of the specification with respect to the embodiment of at least FIG. 3. In particular, page 6, lines 24-28 discloses that "[a]s shown in FIG. 3 this prism 38... comprises... a side face (entrance face) 42 into which light R<sub>i</sub> from a light source 46 is radiated". Further, page 8, lines 10-14 discloses that on "the side of the prism 38 having the exit face 44 is arranged... a photoelectric sensor 52".

Accordingly, the characteristics attributed to Species I are, in fact, illustrated in the embodiment of at least FIG. 3 to which the Official Action attributes solely the characteristics of Species II. Further, the Election of Species requirement also acknowledges that the embodiment of at least FIG. 3 illustrates the identified characteristics of Species II ("a refractometer having a non-adhesive coating sample stage"). Accordingly, the identification of Species I and Species II is incorrect.

The above-noted features of Species III (as identified by the Examiner) are also illustrated in the single embodiment of at least FIG. 3 and described at, e.g., pages 5-8 of the specification with respect to the embodiment of at least FIG. 3. In particular, page 8, lines 14-22 discloses that "[f]ilter means 54 includes a wavelength filter 56, 58".

Accordingly, the characteristics attributed to Species III are, in fact, illustrated in the embodiment of at least FIG. 3 to which the Official Action attributes solely the characteristics of Species II. Further, the Election of Species requirement also acknowledges that the embodiment of at least FIG. 3 illustrates the identified characteristics of Species II ("a refractometer having a non-adhesive coating sample stage"). Accordingly, the identification of Species III and Species II is incorrect.

As explained above, and as set forth in MPEP 806.04(f), the various identified characteristics of the various identified Species are not "mutually exclusive". Accordingly, as described above, the characteristics of the various identified Species are not mutually exclusive as defined in MPEP 806.04(f), and are not characteristics attributable solely to different patentably distinct Species as defined anywhere in the MPEP. Rather, as explained above, the characteristics of the various identified Species are characteristics attributable to a single exemplary embodiment disclosed in at least

FIG. 3, such that the identification of the various alleged Species is incorrect. At least for these reasons, Applicants submit that the Election of Species requirement is inappropriate.

Further, and as noted above, MPEP 803 explicitly sets forth that "if the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits even though they include claims to independent or distinct inventions". In this regard, each of the claims directed to the various identified Species is classified in Class 356, subclass 128. Accordingly, the search for each of these claims would at least partially overlap and thus would not impose any burden on the Examiner.

Accordingly, it is respectfully submitted that requiring election of Species between the claims directed to the various identified Species is inappropriate, regardless of whether the characteristics of such claims are also illustrated, in whole or in part, by way of illustration in different, and in some cases multiple different, drawing figures.

For each of the above reasons, it is respectfully submitted that the Election of Species requirement is inappropriate. Accordingly, reconsideration and withdrawal thereof together with an action on the merits of all of claims 1-17 and 21 (if the Restriction Requirement is not withdrawn) or all of claims 1-21 (if the Restriction Requirement is withdrawn) is respectfully requested in due course.

Nevertheless, should the Restriction Requirement and/or contingent Election of Species requirement not be withdrawn, Applicants have elected the invention identified as Invention 1, to which the claims of Group I comprising claims 1-17 and 21 are

directed (as identified by the Examiner), and the species identified as Species I, upon which claims 1-4 and 21 are readable (as identified by the Examiner). Nevertheless, Applicants submit that for all of the reasons set forth above, the Restriction Requirement and contingent Election of Species requirement are inappropriate, should be withdrawn and an action on the merits of all the claims should be issued in due course.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,  
Yoshinori NAKAJIMA et al.

Joshua M. Povsner  
Reg. #42,086



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Bruce H. Bernstein  
Reg. No. 29,027

July 17, 2006  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191